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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/703,277    10/31/00    PURVIS

H    24104

EXAMINER

PM82/0611

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ART UNIT

PAPER NUMBER

3628

DATE MAILED:

06/11/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/703,277

Applicant(s)

Purvis et al.

Examiner

Andrea Chop

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on (10/31/00 Preliminary Amendment and IDS)
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 20) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Litigation Information***

1. Applicant is reminded of the continuing obligation under 37 CFR 1.56 to timely apprise the Office of any litigation information, or other prior or concurrent proceeding, involving Patent No. 5,842,685, which is material to patentability of the claims under consideration in this reissue application. This obligation rests with each individual associated with the filing and prosecution of this application for reissue. See MPEP §§ 1404, 1442.01 and 1442.04.

### ***Surrendering of Original Patent***

2. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

### ***Oath/Declaration***

3. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414. Also, all inventors have not signed the oath/declaration.

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*Drawings*

4. It should be noted that the drawings have not yet been reviewed by a PTO draftsman. The drawings will be reviewed upon allowance of the application and Applicant will be apprised of their status accordingly.

*Claim Rejections - 35 USC § 112*

5. Claims 12-22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As concerns Claim 12, "said upper side rails" (both occurrences) lacks antecedent basis.

As concerns Claim 13, "said swiveling means" lacks antecedent basis. Also, line 3, "thereon" is indefinite, since it is not clear what is being referred to.

As concerns Claim 14, "said connecting means for *said lower side rails*" and "said *at least one* threaded stud" lack antecedent basis. Also, "said stanchion" is indefinite, since a plurality of stanchions have been defined and it is not clear which is being referred to.

As concerns Claims 15 and 16, "said lower side rails" lacks antecedent basis.

As concerns Claim 18, "the upper ends" lacks antecedent basis.

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### *Double Patenting*

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 12-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-10 of U.S. Patent No. 5,683,074 in view of Bourn et al. US 3,480,257.

The claims of Patent No. 5,683,074 discuss the claimed invention, but lack a means for extending the vertical height of the guard rail system. Bourn et al. teaches the use of a means for extending the vertical height of a guardrail system. It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the guard rail system to have a means for extending the vertical height thereof in view of Bourn et al. in order to provide a more versatile guard rail system which can be adjusted vertically based on the site circumstances, height of workers, etc.

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8. Claims 19-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-10 of U.S. Patent No. 5,683,074 in view of Bourn et al. US 3,480,257 and Stewart, Jr. US 789,242.

The claims of Patent No. 5,683,074 and Bourn et al. show the claimed invention, but lack a ground anchoring means. Stewart, Jr. shows a ground anchoring means (that portion of plate 12 which connects with 13; the other portion of 12 being considered as the anchor bracket). It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the guard rail system to have a ground anchoring means in view of Stewart, Jr. in order to provide a more stable connection to the ground surface.

***Rejection Based upon Recapture - 35 USC § 251***

9. Claims 12-22 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent.

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The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Claims 12-22 do not include the following claim limitations:

"said angulation means comprising a generally L-shaped swivel bracket disposed on said first threaded stud at said top end of said stanchion, said L-shaped bracket including a long leg portion and a short leg portion being fixedly attached in perpendicular relation thereto, said bracket further including swiveling means being adapted for pivoting movement in a plane parallel to the plane defining said long leg portion, said swiveling means including a second threaded stud disposed in perpendicular relation to said axis of said stanchion enabling said upper side rails to be mounted thereon and pivoted in a vertical plane at varying angles for installation of said temporary guardrail system on inclines such as stairs."

Based on the telephone conversation with Applicant on September 30, 1997, these limitations were added to the claims to overcome the 102e/103 rejection, and thus the broader scope

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surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

*Allowable Subject Matter*

10. Claim 12 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 35 USC 251 and the double patenting rejection set forth in this Office action.
11. Claims 13-22 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 35 USC 251 and the double patenting rejection set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
12. Claims 1-11 are allowable over the prior art of record.



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*Conclusion*

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea Chop whose telephone number is (703) 305-6358. The fax numbers for the Group are (703) 305-3597/8.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2168.

*Andrea Chop*  
ANDREA CHOP  
PATENT EXAMINER  
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